

REMARKS

Claims 1-8 and 20-25 are pending in the application. Claims 9-19 have been withdrawn as being non-elected. Two claims are currently amended, and no claims are newly cancelled, withdrawn, or added herein.

Claims 2 and 8 are objected for certain informalities.

Claims 1, 2, 7, 8, 20, 21, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Galiana et al. (US 5,942,954).

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galiana in view of Densert et al (US 6,159,171).

Claim Objections

Claims 2 and 8 are objected to because of the following informalities: the positive recitation of "wherein said devices are drawn from a list including..." appears to claim within the scope of invention a number of structures in the alternative comprising a Markush group. In the interests of advancing prosecution, applicant herein amends claims 2 and 8 by adopting the Examiner's suggested claim language.

Applicant respectfully submits the amendments are provided in "complying with [a] requirement of form expressly set forth in a previous Office action" under 37 C.F.R. § 1.116(b)(1), and do not alter the scope of the claims, and therefore the amendments may be entered. Applicant requests entry of the amendments, and withdrawal of the objections to claims 2 and 8.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 7, 8, 20, 21, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Galiana et al. The Final Office Action does not expressly state that claims 23-25 are rejected, but seems to indicate that they are by arguments presented at page 8.

With regard to claim 1, the Office Action states that Galiana discloses a "head-wearable frame structure adapted for wearing on a subject's head in a condition of positional stability relative thereto" and "an integrated and likewise positionally stable eye-enclosing portion".

A claim is anticipated only if *each and every* element as set forth in the claim is found, either *expressly* or *inherently* described, in a single prior art reference. (*Verdegaal Bros. v. Union Oil Co. of CA*, 814 F.2d 628, 631,

2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131; emphasis provided).

Applicant respectfully submits that Galiana fails to *expressly* or *inherently* disclose either an “eye-enclosing” portion, or that the eye-enclosing portion is “likewise positionally stable” relative to the subject’s head.

First, Galiana fails to *expressly* describe or depict that the “Head’s [sic] Up Display 12” (HUD herein) is eye-enclosing. The Final Office Action states that the recited limitations are *best shown* in Galiana’s FIG. 1, and also cites col. 4, lines 17-65. However, in the 2 July 2008 Non-Final Office Action, the Office expressly stated:

Densert in view of Galiana teaches the claimed invention...*except for expressly disclosing (B) the head-wearable frame structure configured with or including an eye-enclosing vision-obstructing goggle-like visual-input isolating portion* to control visual input by substantially obstructing or limiting the subject’s normal visual range and *securable to a subject’s head in a manner causing the frame structure to function as a non-relative motion unit respect to the subject’s head...*”, (page 5, § 11; emphasis provided).

Applicant respectfully submits that the Office’s current position is inconsistent with its prior stated position, with no explanation having been provided for the change in position.

Inasmuch as the combination of Galiana and Densert fails to disclose the indicated limitations, applicant respectfully submits that Galiana alone necessarily also fails to disclose a “head-wearable frame structure adapted for wearing on a subject’s head in a condition of positional stability relative thereto” and “an integrated and likewise positionally stable eye-enclosing portion”. Therefore, Galiana fails to establish a proper *prima facie* case for rejection under 35 U.S.C. § 102.

As to the Office’s statement that the recited limitations are “best shown in FIG. 1”, FIG. 1 (right) is merely a schematic block diagram depicting a “Target Display 12”, and

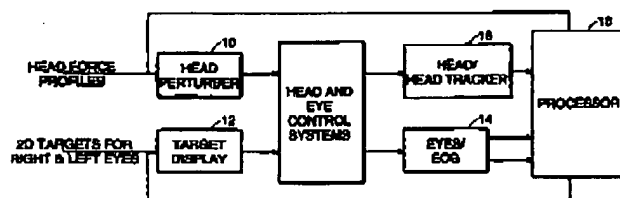


FIG. 1

provides *no evidence* regarding the *structure* of the HUD itself or relative to the Galiana head-worn device(s). Therefore, FIG. 1 necessarily fails to disclose the structural limitations attributed thereto in the Final Office Action (e.g., does not disclose “eye-enclosing” or “positionally stable” structure).

Additionally, *neither* of Galiana's two depicted devices (see FIGS. 3-4, right) depict an eye-enclosing portion, particularly one that is positionally stable relative to the subject's head.

Likewise, regarding the structure of the described but nowhere depicted 'HUD', Galiana describes only that:

Heads-Up Display 12 preferably includes, by way of example, heads-up dual chromic display panels able to provide randomized retinal errors, the display panels being individually controlled for each eye, with up to ± 40 -degree retinal deviations", (Col. 4, lines 47-52).

However, Galiana fails to expressly describe that the HUD, or any portion thereof, or any other portion of the depicted and described devices therein, are eye-enclosing. Nor does Galiana describe that the HUD is integrated with the frame structure in a positionally stable condition. Therefore, there is no evidence in Galiana to support the assertions in the Final Office Action, and Galiana fails to *expressly* disclose one or more limitations recited in claim 1.

Galiana also fails to *inherently* disclose the indicated limitations.

In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art., (MPEP 2112(IV), citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990; emphasis original).

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

One having skill in the art would not consider a HUD to be inherently (necessarily) 'eye-enclosing', nor to be integrated with a head-worn frame structure in a positionally stable condition relative to the subject's head. Instead, one having skill in the art would recognize that a HUD more typically involves an image projected onto or presented at, for example, a windshield of an aircraft or a car.

Head-up displays have also been implemented for automobiles. However, such head-up displays *generally utilize the windshield or apparatus attached to the windshield* as the combiner element. (US 5,028,119 to Hegg, et al., 1991; col. 1, lines 39-42; emphasis provided).

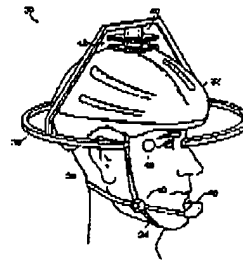


FIG. 3

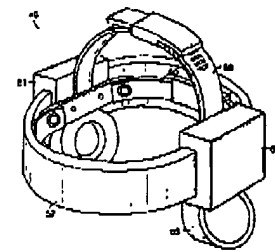
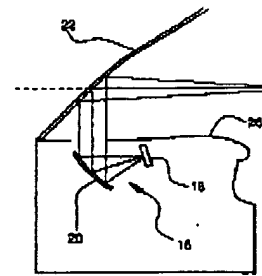


FIG. 4

Referring to FIGS. 1 and 2 [see below], a vehicle 10 is equipped with...a *head up display* (HUD) system 16 including an image source or display 18 connected to the video processor output, and an aspheric mirror 20 which reflects the display image *to the vehicle windshield 22*[.] (US 5,414,439 to Groves et al., 1995; col. 2, lines 45-53; FIG. 2; emphasis provided).

FIG - 2



One having skill in the art will recognize that with a HUD, the user's head remains free to turn independently from the HUD or any images displayed thereupon, so is not at all positionally stable relative to the user's head or any head-worn structure.

Likewise, one having ordinary skill in the art will recognize that a HUD at the windshield of a car or another vehicle does not "substantially obstruct the subject's normal visual range" as recited in claim 1 (for example), as to do so would render the vehicle dangerous to operate. Instead, the user's view is intentionally relatively unobstructed by the HUD.

Display of vehicle instrument data in a head-up mode (head-up display or HUD) against the view through the windscreen may be achieved by placing a dichroic reflector in front of the windscreen...the pilot may simultaneously see through the dichroic reflector and thus have a *relatively unobstructed view* through the windscreen. (US 4,439,755 to LaRussa, 1984; col 1, lines 39-57; emphasis provided)

Additionally, the user's field of view also remains virtually unobstructed, inasmuch as they can look away from the windshield (e.g., downward at a control panel, or out a side window) and no images displayed at the HUD will remain within their field of view.

Even if HUDs *could* be eye-enclosing, which applicant does not concede, such possibility does not satisfy established requirements for providing inherent disclosure.

Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

The record does not include any evidence supporting the assertion that a HUD is inherently (necessarily) eye enclosing, and "[t]he standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA)".

See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). See also MPEP § 1216.01. Instead, applicant respectfully submits that the record includes substantial evidence that Galiana's described HUD is not eye-enclosing.

Therefore, applicant respectfully submits that Galiana fails to inherently (*necessarily*) disclose each and every element as set forth in claim 1.

Further still, and contradicting the assertions in the Final Office Action, Galiana expressly states that the subject's head is free to move, enabling the subject to track a moving target.

In accordance with preferred embodiments of the invention, experimental protocol designs provide for presentation to the subject of optimal stimuli and for recording head and binocular positions while *the subject's head is free to assist target tracking*, (col. 4, lines 32-36; emphasis provided).

Galiana's described "randomized visual targets...presented to the subject, for example, by a Head's Up Display 12", (col. 4, lines 21-23), leaving 'the subject's head...free to assist target tracking' is consistent with a HUD that is separate from the subject's head (e.g., displayed at a windshield of a vehicle, etc.).

However, Galiana's HUD is not consistent with one that is positionally stable relative to, and integrated with a frame structure that is worn on, the subject's head. If, as asserted, the Galiana HUD were eye-enclosing and positionally stable relative to the subject's head, head movement would not aid the subject in target tracking. Instead, despite movement of the head, the position of the target relative to the eye(s) would remain constant (positionally stable), and head movement would necessarily fail to "assist target tracking".

For at least these reasons, applicant respectfully submits that the Examiner's *initial assessment* stated in the 16 December 2008 Interview Summary is correct, that "the proposed amendments appear to overcome the applied prior art of record", including Galiana. Galiana fails to *expressly or inherently* describe *one or more* of the elements as set forth in the claim, particularly the indicated limitations.

Therefore, applicant respectfully submits that Galiana fails to establish a *prima facie* basis for the asserted rejection of claim 1 under 35 U.S.C. § 102(b), and applicant requests withdrawal of the rejection and allowance of claim 1 without delay.

For at least the same reasons, applicant submits Galiana fails to expressly and/or inherently disclose a "frame structure comprising an integrated and likewise non-relative motion, *substantially vision-obstructing goggle-like portion*", "wearably securable to a subject's head in a manner causing the frame structure to function as a non-relative-motion

unit with respect to the subject's head", as recited in independent claim 7. Lastly, Galiana also fails to expressly and/or inherently disclose "a frame structure seated with positional stability on and relative to the subject's head" and "a likewise positionally stable eye-enclosing, visual-input isolating and controlling portion integral with the frame structure", as recited in independent claim 20.

Applicant respectfully submits that Galiana fails to establish a *prima facie* basis for the asserted rejections of claims 7 and 20 under 35 U.S.C. § 102(b), and applicant likewise requests withdrawal of the rejections and allowance of the claims without delay.

Lastly, inasmuch as claims 2, 8, and 21-22 depend from and include the distinct limitations of claims 1, 7, and 20, respectively, applicant respectfully submits that Galiana fails to establish a *prima facie* basis for the asserted rejections of claims 2, 8, and 21-22, and likewise requests withdrawal of the rejections and allowance of those claims without delay.

Claim Rejections – 35 U.S.C. § 103

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galiana in view of Densert et al (US 6,159,171).

Claims 3-6 depend from and include the distinct limitations of independent claim 1, as discussed above. And as also discussed above, the Office previously acknowledged that the combination of Galiana and Densert fail to remedy the failures of Galiana as discussed above.

Densert in view of Galiana teaches the claimed invention...*except for expressly disclosing* (B) the head-wearable frame structure configured with or including an eye-enclosing vision-obstructing goggle-like visual-input isolating portion to control visual input by substantially obstructing or limiting the subject's normal visual range and securable to a subject's head in a manner causing the frame structure to function as a non-relative motion unit respect to the subject's head...", (2 July 2008 Non-Final Office Action, page 5, § 11).

Applicant respectfully submits that the Office's current position is directly contrary to the Office's prior stated position, with no explanation entered in the record for the change in position. Therefore, applicant respectfully submits that the Office has not presented a proper *prima facie* case for rejection under 35 U.S.C. § 103(a). Rather, the Office's own evidence and statements in the record expressly demonstrate that the claims 3-6, including as they do the distinct limitations of independent claim 1, are allowable over the asserted references Galiana and Densert, either alone or when combined.

For at least these reasons, applicant respectfully requests withdrawal of the asserted 35 U.S.C. § 103(a) rejections of claims 3-6, and allowance of the same without delay.

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CONCLUSION

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Applicant respectfully submits that the claims have been exhaustively examined by the Office, over the course of a lengthy prosecution, and that all pending claims are allowable. Therefore, applicant respectfully requests withdrawal of all rejections therefrom and allowance of the application on the merits.

Further, if the Examiner agrees that the pending claims are allowable as presented herein, the Examiner is hereby permitted to cancel by Examiner amendment each claim designated herein as 'Withdrawn'. Applicant does not, by granting such permission, concede anything with regard to the patentability of the withdrawn claims, and expressly reserves the right to present the withdrawn claims in a continuation or other application as permitted by the applicable regulations.

The Examiner is encouraged to telephone the undersigned at (503) 226-1191 to resolve any purely formal matters.

Respectfully submitted,

/Patrick D. Boyd/

Patrick D. Boyd
Reg. No. 54,671
Ater Wynne LLP
1331 NW Lovejoy Street, Suite 900
Portland, Oregon 97209

Customer No. 35940

